

Applicant: Kelly S. Stack
Serial No.: 10/602,446
Filing Date: June 24, 2003
Docket No.: STK-001

REMARKS

Reconsideration and allowance are respectfully requested.

Before entry of this amendment, claims 1-5 and 7-21 were pending. In the Office Action, claims 1-5 and 7-21 were rejected. In the present amendment, claims 1, 11 and 19 are amended, and claim 22 is added. After entry of the amendment, claims 1-5 and 7-22 are pending.

I. Claims 1-4, 7-10

Claims 1-4, 7-10 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Wilson et al. (published as 2004/0098073 and issued as US Pat. 7,060,086) in view of Cipolla (US Pat. 5,458,628) in further view of Rucki (U.S. Pat. 5,679,052) (Office Action, p. 3, lines 17-18).

A. Independent claim 1

Claim 1 as amended recites, "a bracelet . . . attached around an infant's wrist, . . . wherein at least one of the plurality of capsules is approximately as large as the infant's mouth, and wherein one of the plurality of capsules is partially inside the infant's mouth." (emphasis added). The three-way combination of Wilson, Cipolla and Rucki does not form the basis for a valid rejection of claim 1 under § 103(a) because the references when combined do not teach any of (i) a bracelet attached around an infant's wrist, (ii) capsules that are approximately as large as the infant's mouth, or (iii) a capsule partially inside the infant's mouth.

- (i) None of the references teaches a bracelet attached around an infant's wrist.

The Examiner does not state that Wilson teaches a bracelet attached around an infant's wrist. The Examiner has argued, however, that "Wilson et al. discloses that the wearer of a cooling device may be a child [0046], which

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defines an age range that includes infants" (Office action dated 11/17/2006, p. 5, lines 8-9). In the Office Action, the Examiner continues, "The examiner is considering a child to include an age range that includes infants. No ages are indicated in the instant specification for the term "infant" and it seems to the examiner that a 1 yr old, for example, could be called a child or an infant." (Office Action, p. 3, lines 21-23). Applicant maintains that an infant is commonly defined as being less than one years old, and Applicant disavowes claim scope to the Examiner's unconventional interpretation of the term "infant" to include a child who is more than one years old.

The Examiner is impermissibly extending the single use of the word "children" in one paragraph of Wilson to argue that Wilson teaches applying thermal treatment packs to infants. Wilson also does not mention infants or babies. And Wilson does not teach that the age range of "children" who wear thermal treatment pack 100 includes infants. To the contrary, Wilson is directed to the treatment of injured limbs. (See, e.g., Wilson, col. 1, lines, 14, 28, 30-31, 37, 42, 47, 49, 54, 56, 59-60, 62-63, 66; col. 2, lines 4, 10, 18, 23, 25, 27, 31, 33, 35, 38-39, 41-42, 44-45, 47, 50, 54, 67) Wilson does not suggest that infants require treatment for injured limbs. Nor does Wilson suggest that thermal treatment pack 100 should be used on injured limbs of infants. Indeed, one of ordinary skill in the art of the treatment of injured limbs is not necessarily one of ordinary skill in the art of the treatment of infants.

- (ii) None of the references teaches a bracelet with capsules that are approximately as large as the infant's mouth.

Wilson teaches "water filled capsules are preferably small, such as the size of peas, and substantially spherical, which allows the thermal treatment pack to comfortably conform to limbs" (Wilson, para. [0042]) (emphasis added). Wilson does not teach that the capsules are approximately as large as the infant's mouth around whose wrist the bracelet is attached.

Neither Cipolla nor Rucki teaches a bracelet with capsules.

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- (iii) None of the references teaches a bracelet with a capsule partially inside the infant's mouth.

None of the references teaches a bracelet with capsules attached around an infant's wrist having one of the capsules partially inside the infant's mouth.

- (iv) Statutory subject matter includes a bracelet attached around an infant's wrist and a capsule partially inside the infant's mouth.

Originally filed claim 1 recited "a bracelet, the bracelet enclosing a volume and attached around an infant's wrist". In the Office action dated 6/14/2006, the Examiner rejected claim 1 as being directed to non-statutory subject matter. The Examiner stated:

"Claim 1 positively recites an infant's wrist; a limitation of the claim is the bracelet being attached around an infant's wrist. Claims directed to or including within their scope a human being are not considered to be patentable subject matter. The claim must be reworded to include the limitation of being *adapted to be attached to an infant's wrist.*" (Office action dated 6/14/2006, p. 2, lines 8-12) (underlined emphasis added; italics in original)

Applicant respectfully disagrees with the Examiner's interpretation of the law concerning the patentability of a human being. The Examiner provides no authority for the proposition that a claim may not positively recite an infant's wrist. The Examiner is requested to provide such authority.

Applicant contends that the law does not prohibit positively reciting a part of a human body. A claim to an apparatus in contact with the human body does not impermissibly claim an apparatus encompassing a human being. Allowable claims commonly recite an object in contact with a specific body part. For example, the following issued U.S. Patents have claims that recite a bracelet around a user's wrist: USP 6,443,978 (Claim 62: "... said substrate comprises a bracelet grasping the wrist of the patient"); USP 6,473,023 (Claim 9: "... wherein the device is a bracelet worn by the user"); USP 6,687,675 (Claim 10: "... tamperproof means clasps said bracelet about the wrist of the user"); USP

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6,567,523 (Claim 19: "... said battery power source extends circumferentially around at least a portion of said wearer's wrist"); USP 6,227,006 (Claim 8: "... when the bracelet is wrapped around the wearer's wrist . . ."); USP 6,757,390 (Claim 1: "... when the wristwatch type wireless telephone is worn on the user's wrist . . ."). In addition, the following issued U.S. Patents have claims that recite objects in a human mouth: USP 6,139,566 (Claim 1: "... when the the resilient nipple is positioned in a mouth of the infant"); USP 6,068,649 (Claim 1: "... when said pacifier is positioned in a mouth of the infant whereby said pacifier is secured within the mouth of the infant"); USP 7,234,933 (Claim 1: "A dental appliance which is placed in a mouth of a user . . .")

Applicant amends claim 1 to include the original recitation of a bracelet attached around an infant's wrist. None of Wilson, Cipolla or Rucki teaches either a bracelet attached around an infant's wrist or a capsule inside the infant's mouth.

- (v) The limitation of a capsule approximately as large as an infant's mount is supported by the figures.

Amended claim 1 recites, "at least one of the plurality of capsules is approximately as large as the infant's mouth". Support for claiming the approximate size of the capsules is provided by figures 1 and 5. Support for a dimension need not be found in the text of a patent application, but may be found in the figures of the written description. *Koito Mfg. Co. v. Turn-Key-Tech, LLC*, 381 F.3d 1142, 1154, 72 USPQ2d 1190 (Fed. Cir. 2004).*

* The Federal Circuit explained in *Koito*:

"... Instead, we have explained that the written description requirement can be satisfied by "words, structures, *figures, diagrams*, formulas, etc." *Lockwood v. Am. Airlines, Inc.*, 107 F.3d 1565, 1572 (Fed. Cir. 1997) (emphasis added).

...
We thus affirm the district court's determination that, as a matter of law, the limitation "significantly thicker and wider" finds adequate support in Figure 1 of the written description of the patent. Dr. Kazmer's conclusory testimony to the contrary, which ignores the embodiment of the invention described by Figure 1, is thus insufficient to show failure of written description." (*Koito*, 381 F.3d at 1154-1155) (underlined emphasis added)

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Wilson, Cipolla and Rucki do not form the basis for a valid rejection of claim 1 under § 103(a) because none of the references teaches (i) a bracelet attached around an infant's wrist, (ii) capsules that are approximately as large as the infant's mouth, or (iii) a capsule partially inside the infant's mouth. Reconsideration of the § 103(a) rejection and allowance of claim 1 are requested.

B. Dependent claims 2-4 and 7-10

Claims 2-4 and 7-10 depend directly or indirectly from claim 1 and are allowable for at least the same reasons for which claim 1 is allowable. Reconsideration of the § 102(e) rejection and allowance of claims 2-4 and 7-10 are requested.

II. Dependent claim 5

Claim 5 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Wilson in view of Cipolla, in view of Rucki and further in view of Brink (USP 5,843,145) (Office Action, p. 6, lines 13-14).

Claim 5 includes the following limitations of base claim 1, "a bracelet . . . attached around an infant's wrist, . . . wherein at least one of the plurality of capsules is approximately as large as the infant's mouth, and wherein one of the plurality of capsules is partially inside the infant's mouth." (emphasis added). The four-way combination of Wilson, Cipolla, Rucki and Brink does not form the basis for a valid rejection of claim 5 under § 103(a) because none of the references teaches any of (i) a bracelet attached around an infant's wrist, (ii) capsules that are approximately as large as the infant's mouth, or (iii) a capsule partially inside the infant's mouth.

As explained above with regard to claim 1, none of Wilson, Cipolla or Rucki teaches any of these limitations. Brink also does not teach (i) a bracelet

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attached around an infant's wrist, (ii) capsules that are approximately as large as the infant's mouth, or (iii) a capsule partially inside the infant's mouth.

Because Wilson, Cipolla, Rucki and Brink do not teach all of the limitations of claim 5, reconsideration of the § 103(a) rejection and allowance of claim 5 are requested.

III. Claims 11-16 and 19-21

Claims 11-16 and 19-21 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Wilson in view of Cipolla (Office Action, p. 7, lines 3-4).

A. Independent claim 11

Claim 11 recites, "attaching the bracelet to a wrist of an infant . . . wherein at least one of the plurality of capsules is approximately as large as an infant's mouth". The combination of Wilson and Cipolla does not form the basis for a valid rejection of claim 11 under § 103(a) because the references when combined do not teach either (i) attaching the bracelet to a wrist of an infant, or (ii) a capsule approximately as large as an infant's mouth.

As explained above with regard to claim 1, Wilson does not teach that the age range of the "children" who wear thermal treatment pack 100 includes infants. Interpreting the single mention in Wilson of the word "children" in paragraph [0046] as teaching the application of thermal treatment packs to infants inaccurately describes the disclosure of Wilson. Wilson does not mention infants or babies, and does not suggest that thermal treatment pack 100 should be used on injured limbs of infants. Thus, Wilson does not teach attaching a bracelet to a wrist of an infant. And Wilson does not teach a capsule approximately as large as an infant's mouth.

Cipolla does not mention infants or babies. And Cipolla does not mention a bracelet or a capsule.

Reconsideration of the § 103(a) rejection and allowance of claim 11 are requested.

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B. Dependent claims 12-16

Claims 12-16 depend directly or indirectly from claim 11 and are allowable for at least the same reasons for which claim 11 is allowable. Reconsideration of the § 102(e) rejection and allowance of claims 12-18 are requested.

C. Independent claim 19

Claim 19 recites a teether. In addition, claim 19 as amended recites, "the capsule is approximately as large as an infant's mouth; and means . . . for allowing the infant to suck on the capsule through the means". The combination of Wilson and Cipolla does not form the basis for a valid rejection of claim 19 under § 103(a) because the references when combined do not teach any of (i) a teether, (ii) a capsule approximately as large as an infant's mouth, or (iii) a means for allowing the infant to suck on the capsule.

Neither Wilson nor Cipolla teaches a teether. The Examiner has not established a *prima facie* case of obviousness because the Examiner has not stated that either Wilson or Cipolla teaches a teether. Neither Wilson nor Cipolla even mentions teeth.

In addition, neither Wilson nor Cipolla teaches a teether containing a capsule approximately as large as an infant's mouth.

Finally, neither Wilson nor Cipolla teaches a teether with means for allowing the infant to suck on the capsule through the means. The Examiner states that "Wilson as modified by the teachings of Cipolla discloses . . . means . . . for allowing the infant to suck on the capsule through the means" (Office Action, p. 8, lines 18-21). Applicant respectfully disagrees. neither Wilson nor Cipolla mentions an infant. neither Wilson nor Cipolla mentions sucking. Wilson does not mention that the "film" can or should be placed in the mouth. Cipolla does not mention that the "material" can or should be placed in the mouth. The Examiner has not pointed to specific teachings in either Wilson or Cipolla that teach a means for allowing the infant to suck on a capsule through the means.

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For these reasons, reconsideration of the § 103(a) rejection and allowance of claim 19 are requested.

D. Dependent claims 20-21

Claims 20-21 depend from claim 19 and are allowable for at least the same reasons for which claim 19 is allowable. Reconsideration of the § 103(a) rejection of claim 20 and allowance of claims 20-21 are requested.

IV. Claims 17-18

Claims 17-18 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Wilson in view of Cipolla and further in view of Rucki (Office Action, p. 9, lines 8-10).

Claims 17-18 depend directly or indirectly from claim 11 and include the following limitation of base claim 11: "attaching the bracelet to a wrist of an infant . . . wherein at least one of the plurality of capsules is approximately as large as an infant's mouth". Claims 17-18 are allowable because none of Wilson, Cipolla or Rucki teaches either (i) attaching the bracelet to a wrist of an infant, or (ii) a capsule approximately as large as an infant's mouth.

As explained above with regard to claim 11, neither Wilson nor Cipolla mentions infants or babies. Wilson does not suggest that thermal treatment pack 100 should be used on injured limbs of infants, so Wilson does not teach attaching a bracelet to a wrist of an infant. And Wilson does not teach a capsule approximately as large as an infant's mouth. Cipolla does not mention a bracelet or a capsule.

In addition, Rucki does not mention an infant, a baby, a bracelet, a wrist or a mouth.

Reconsideration of the § 103(a) rejection of claims 17-18 and allowance of claims 17-18 are requested.

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V. New claim 22

Applicant is adding new claim 22, which is supported by the specification and allowable over the cited references. No new matter is added.

VI. Conclusion

In view of the foregoing amendments and remarks, Applicant respectfully submits that the entire application (claims 1-5 and 7-22 are pending) is in condition for allowance. Applicant respectfully requests that a timely Notice of Allowance be issued in this case. If the Examiner would like to discuss any aspect of this application, the Examiner is requested to contact the undersigned at (925) 550-5067.

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

By *Darien K. Wallace*
Darien K. Wallace

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Respectfully submitted,

Darien K. Wallace

Darien K. Wallace
Attorney for Applicants
Reg. No. 53,736
Customer No. 47,713